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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **C.O. (COMM.IPD-TM) 117/2021**

BENNET, COLEMAN AND COMPANY LIMITED

..... Plaintiff

Through: Ms. Mamta Rani Jha and Mr.
Shakti Nair and Ms. Pragya Jain, Advs.

versus

VNOW TECHNOLOGIES PRIVATE LIMITED AND ANR.

..... Defendant

Through: None

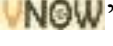
CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR

J U D G M E N T (ORAL)

14.02.2023

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1. This rectification petition, under Section 57¹ of the Trade Marks Act 1999, was initially filed before the learned Intellectual Property Appellate Board (the learned IPAB) as IPAB Case No. ORA/92/2020/TM/DEL, seeking rectification of the register of Trade Marks by removal, from the services in respect of which the mark 'VNOW/' stands registered in favour of Respondent 1, 'Transmission, Reception & Sharing Of Downloadable Digital Data & Content, Electronic Communication Services, Providing Access To GPS/Lbs/Other Navigation Services, Access To Electronic

¹ 57. **Power to cancel or vary registration and to rectify the register. –**

(1) On application made in the prescribed manner to the High Court or to the Registrar by any person aggrieved, the Registrar or the High Court, as the case may be, may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the High Court or to the Registrar, and the Registrar or the High Court, as the case may be, may make such order for making, expunging or varying the entry as it may think fit.

Communication Network, Web Casting/Online/ Offline Services For Transmission Or Reception Of Audio/Video/Data Files & Content, Multimedia, Access To Internet/Web Services/Tv/ Telecommunication Services Via Telecommunication Equipment Or Smart Phones Or Mobile Phones Or Wearable Devices Or Smart Watches Or Watches Or Wireless (2g/3g/4g/5g/7g/WIFI/WIMAX/VSAT) Enabled Devices Or GPS/ GPRS Enabled Device, Bluetooth Enabled Devices, Tablet Computer Transmission, Reception, Sharing & Communication Of Software Or Computer Applications Or Mobile Applications Or Smart Devices Applications Or Audio Or Video Or Downloadable Digital Content Or Web/ Internet /Online Data Sharing’.

2. Notice was issued on the petition, by the learned IPAB, on 28th September 2020. Thereafter, the matter was listed before the learned IPAB on 23rd March 2021. Consequent to the enactment of the Tribunals Reforms Act, 2021 and transfer of the matter to this court, the petition was listed before this Court on 14th January 2022, 26th April 2022, 11th July 2022, 6th September 2022, 28th October 2022, 14th December 2022 and 16th January 2023.

3. Respondent 1, despite service by both before the learned IPAB as well as this Court, has remained continuously absent. As such, the court has heard Ms. Mamta Rani Jha, learned Counsel for the petitioner, and, having perused the record, proceeds to dispose of the present petition.

4. The petitioner is the registered proprietor of the following trade marks:

Sl. No.	Trade Marks	Services covered under the trade mark
1.	TIMES NOW	TELEVISION AND RADIO BROADCASTING, CABLE TELEVISION BROADCASTING, NEWS AGENCIES PROVIDING TELECOMMUNICATIONS AND USER ACCESS TO A GLOBAL COMPUTER NETWORK AND SERVICES, TELECOMMUNICATION AND COMMUNICATION BY COMPUTER TERMINALS, CELLULAR TELEPHONE SERVICES, OPTIC FIBRE NETWORKS, TELEGRAMS AND TELEPHONE, ELECTRONIC AND FACSIMILE TRANSMISSION, TRANSMISSION OF MESSAGE AND IMAGE, WIRE SERVICE.
2.	ET NOW	TELEVISION & RADIO BROADCASTING, CABLE TELEVISION BROADCASTING, NEWS AGENCY PROVIDING TELECOMMUNICATION & USER ACCESS TO GLOBAL COMPUTER NETWORK SERVICES, TELECOMMUNICATION AND COMMUNICATION BY COMPUTER TERMINALS, CENTRE TELEPHONE SERVICES, OPTIC FIBRE NETWORKS, TELEGRAM & TELEPHONE, ELECTRONIC FACSIMILE TRANSMISSION, TRANSMISSION OF MESSAGE & IMAGE, WIRE SERVICE
3	MOVIES NOW	TELEVISION AND RADIO BROADCASTING CABLE TELEVISION BROADCASTING; SATELLITE TRANSMISSION; NEWS AGENCIES; PROVIDING TELECOMMUNICATIONS AND USER ACCESS TO A GLOBAL COMPUTER NETWORK AND SERVICES, TELECOMMUNICATIONS AND COMMUNICATION BY COMPUTER TERMINALS, CELLULAR TELEPHONE SERVICES; OPTIC FIBRE NETWORKS, TELEGRAMS AND TELEPHONE, ELECTRONIC AND FACSIMILE TRANSMISSION; TRANSMISSION OF NEWS, MESSAGES AND IMAGES THROUGH GLOBAL COMPUTER NETWORK; WIRE SERVICE
4	MIRROR NOW	TELECOMMUNICATIONS, TELEVISION BROADCASTING, CELLULAR TELEPHONE COMMUNICATION, COMMUNICATIONS BY COMPUTER TERMINALS, INTERNET AND WEBSITES, INTERNET PORTALS, INTERNET BROADCASTING, ELECTRONIC

Signature Not Verified

Digitally Signed
By: KAMLA KAWAT
Signing Date: 15.02.2023
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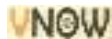
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		MAIL, PROVIDING ONLINE FORUMS, SATELLITE TRANSMISSION, COMPUTER AIDED TRANSMISSION OF MESSAGES AND IMAGES, PROVIDING ACCESS TO DATABASES, FACSIMILE TRANSMISSION, PROVIDING USER ACCESS TO GLOBAL COMPUTER NETWORKS, PROVIDING TELECOMMUNICATIONS CONNECTIONS TO A GLOBAL COMPUTER NETWORK, TRANSMISSION OF DIGITAL FILES, TRANSMISSION OF CARDS ONLINE.
5	ROMEDY NOW	TELEVISION & RADIO BROADCASTING, CABLE TELEVISION BROADCASTING; NEWS AGENCIES' PROVIDING TELECOMMUNICATIONS & USER ACCESS TO A GLOBAL COMPUTER NETWORK & SERVICES; TELECOMMUNICATIONS & COMMUNICATION BY COMPUTER TERMINALS; CELLULAR TELEPHONE SERVICES; OPTIC FIBER NETWORKS TELEGRAMS & TELEPHONE; ELECTRONIC & FACSIMILE TRANSMISSION; TRANSMISSION OF MESSAGES & IMAGES; WIRE SERVICE.

5. The petitioner claims to have adopted the mark 'NOW', as a distinct and dominant part of its various marks aforesaid in 2004 and commenced use of the said mark as part of the mark 'TIMES NOW' in 2006. Times Now, as is well-known, is a news channel which attracts considerable viewership and is viewed both within and outside the country. Following the success of Times Now, the petitioner launched a business news channel under the mark 'ET Now' in June 2009. Closely following thereupon, 'Movies Now' as a television channel featuring Hollywood films, was launched by the petitioner in 2010, 'Romedy Now', a television showing romantic and comedy Hollywood films was launched in September 2013 and 'Magic Bricks Now', a television channel providing information with respect to real estate and property was launched on 31st October 2015. Magic Bricks Now was renamed Mirror Now in 2017.

6. The petitioner felicitously refers to the aforesaid marks ‘TIMES NOW’, ‘ET NOW’, ‘MOVIES NOW’, ‘MIRROR NOW’ and ‘ROMEDY NOW’ as “the NOW centric trade marks”. By dint of continuous usage as well as the rights that accrue in favour of the petitioner consequent to the aforesaid registrations held by it, the petitioner asserts that it has exclusive rights to use the expression ‘NOW’ as any part of a trade mark in respect of services relatable to Class 38. The petition also avers that, owing to the reputation that the petitioner’s services have garnered over time, the afore-noted registered trademarks of the petitioner are entitled to be regarded as ‘well-known trade marks’ within the meaning of Section 2(1)(zg)² of the Trade Marks Act.

7. The mark  stands registered by the Registrar of Trade Marks in favour of Respondent 1 in Class 38, covering “transmission, reception & sharing of downloadable digital data & content, electronic communication services, providing access to GPS/lbs/other navigation services, access to electronic communication network, web casting/online/ offline services for transmission or reception of audio/video/data files & content, multimedia, access to internet/web services/tv/telecommunication services via telecommunication equipment or smart phones or mobile phones or wearable devices or smart watches or watches or wireless (2g/3g/4g/5g/7g/WIFI/WIMAX/VSAT) enabled devices or GPS/ GPRS enabled device, Bluetooth enabled devices, tablet computer or smart

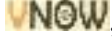
² 2. **Definitions and interpretation. –**

- (1) In this Act, unless the context otherwise requires, –
(zg) “well-known trade mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person during the mark in relation to the first-mentioned goods or services.

security solution devices, power bank, transmission, reception, sharing & communication of software or computer applications or mobile applications or smart devices applications or audio or video or downloadable digital content or chats or social networking services or conferences or webinars or web/ internet/online data sharing”.

8. The petitioner objects. Ergo this petition, seeking rectification of the Trade Marks register by restricting the registration of the **VNOW** mark, in the respondent’s favour, to “smart security solution devices, power bank, chats or social networking services or conferences or webinars” and deleting, therefrom, all other services covered by the registration as it stands today. For the sake of convenience and nothing else, I would allude to the services of which the petitioner seeks evisceration from the respondent’s registration, as “the impugned services”.

9. The use, in the impugned **VNOW** mark, of ‘NOW’, according to the petitioner, would lead to confusion in the minds of the public, in view of the registration held by the petitioner in respect of its ‘NOW’-centric trademarks. ‘NOW’, submits Ms Mamta Rani Jha arguing for the petitioner, is an essential and dominant feature of the impugned **VNOW** mark, just as it is a dominant feature of the ‘NOW’-centric trademarks of the petitioner. Inasmuch as the services provided by the respondent under the impugned **VNOW** mark are largely identical to the services provided by the petitioner under its registered marks, Ms Jha asserts that a viewer, possessed of average intelligence and imperfect recollection, who views the channel of the respondent under the impugned **VNOW** mark, would be inclined to regard the services provided by the petitioner as coming from, or at least having an

association with the petitioner. She, therefore, contends that the impugned mark , to the extent it includes, within its ambit, services which are covered by the petitioner's 'NOW'-centric marks, infracts (1), (2), (3)(a) and (10) of Section 11³ read with Section 29 of the Trade Marks Act is non-registrable and that its continuance on the Register of Trade Marks in its present form is, therefore, violative of the law. Resultantly, the petitioner seeks rectification of the register by deleting, therefrom, the impugned services.

10. Having heard Ms. Mamta Rani Jha, learned Counsel for the petitioner, and perused the record, it is apparent, from the record, that the petitioner has registrations, in its favour, of several marks which involve 'NOW' as the latter part of the mark, under class 38. The submission of Ms. Mamta Rani Jha is that, in the circumstances, an unwary viewer who views the defendant's channel, which provides identical services under the impugned  mark, would be inclined to draw an association between the impugned mark and the

³ 11. **Relative grounds for refusal of registration. –**

- (1) Save as provided in Section 12, a trade mark shall not be registered if, because of –
 - (a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or
 - (b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,
 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
- (2) A trade mark which –
 - (a) is identical with or similar to an earlier trade mark; and
 - (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor,
 shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.
- (3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented –
 - (a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or
 - (b) by virtue of law of copyright.

- (10) While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall –
 - (i) protect a well-known trade mark against the identical or similar trade marks;
 - (ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark.

‘NOW centric’ marks of the plaintiff, merits acceptance.

11. That proprietary rights can emerge even from a family of marks held by a registrant, in which part of the marks may be common, stands recognized by a Division Bench of this Court in *Amar Singh Chawal Wala v. Shree Vardhman Rice & General Mills*⁴, which has been followed by another Division Bench in *Kirorimal Kashiram Marketing v. Shree Sita Chawal Udyog Mill*⁵. One may usefully reproduce, in this context, para 18 of the report in *Amar Singh Chawal Wala*⁴:

“18. It is not possible to agree with the reasoning of the learned Single Judge that the word QILLA is not associated with rice and therefore no ordinary purchaser of rice would associate the Defendant's mark as that of the Plaintiffs. It is plain from the pleadings that the Plaintiff has been using the words QILLA consistently in connection with the rice being sold by them with only the first word indicating the colour viz., GOLDEN, LAL or NEELA. *It must be held that the Plaintiff has been able to prima facie show that it has developed a ‘family of marks’ and that by merely changing the first word from GOLDEN, LAL or NEELA to the word HARA there is every possibility of confusion being caused both in trade and in the mind of any person desiring to purchase rice.* Likewise the use of the picture or depiction of a fort in the background on the label/packing of the rice is also likely to cause confusion in the mind of the purchaser and in the trade that the product being sold by the Defendants are in fact those manufactured by the Plaintiff.”

(Emphasis supplied)

In a similar vein, the High Court of Bombay, in *Neon Laboratories Ltd v. Themis Medicare Ltd*⁶, held the “XYLOX family of marks” comprising XYLOX 2%, XYLOX HEAVY, XYLOX GEL, XYLOX ADRENALINE and XYLOX 2% Jelly to be infringing the “LOX family of marks” comprising LOX 2% ADRENALINE, LOX 4%, LOX 5%, LOX HEAVY 5%, LOX VISCOUS, LOXALPRIN, LOXALPRY, LOXIMLA, PLOX and RILOX.

⁴ ILR (2009)VI Delhi 399

⁵ AIR 1963 SC 449

12. The ‘NOW’-centric ‘TIMES NOW’, ‘ET NOW’, ‘MOVIES NOW’, ‘MIRROR NOW’ and ‘ROMEDY NOW’ marks constitute a “family of marks” within the meaning of the concept as understood in *Amar Singh Chawal Wala*⁴ and *Neon Laboratories*⁶, especially as they cover services provided in the same Class 38. I will refer to the registered trade marks of the plaintiff, therefore, as “the ‘NOW’ family of marks” hereinafter, instead of “the ‘NOW’-centric marks”.

13. Section 17(1)⁷ clarifies that the proprietorial rights conferred by registration is for the mark as a whole. In other words, the rights conferred on the petitioner by the registrations held by it in respect of the NOW family of marks are over the TIMES NOW, ET NOW, ROMEDY NOW, MOVIES NOW and MIRROR NOW marks as a whole in each case, and not for the mark ‘NOW’ *per se*. Section 17(2)(a)⁸ makes matters clearer, by disentitling exclusivity in respect of part of a mark which is registered as a whole. This has, over time, come to be known as “the anti-dissection rule”.

14. The registrations held by the petitioner in the ‘NOW’ family of marks confers, therefore, on it, rights to claim exclusivity in respect of each of the marks *as a whole*, and not in respect of the ‘NOW’ part of each of the marks.

⁶ (2014) 60 PTC 621

⁷ 17. **Effect of registration of parts of a mark. –**

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

⁸ (2) Notwithstanding anything contained in sub-section (1), when a trade mark –

(a) contains any part –

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,

the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

15. The anti-dissection rule is, however, subject to a caveat, elucidated thus by Pradeep Nandrajog, J. (as he then was), speaking for a Division Bench of this Court, in *South India Beverages Pvt Ltd v. General Mills Marketing Inc.*⁹:

“19. Though it bears no reiteration that while a mark is to be considered in entirety, yet it is permissible to accord more or less importance or ‘dominance’ to a particular portion or element of a mark in cases of composite marks. Thus, a particular element of a composite mark which enjoys greater prominence vis-à-vis other constituent elements, may be termed as a ‘dominant mark’.

20. At this juncture it would be apposite to refer to a recent decision of this Court reported as *Stiefel Laboratories v. Ajanta Pharma Ltd*¹⁰. The Court whilst expounding upon the principle of ‘anti-dissection’ cited with approval the views of the eminent author on the subject comprised in his authoritative treatise-McCarthy on Trademarks and Unfair Competition. It was observed:

“41. The anti-dissection rule which is under these circumstances required to be applied in India is really based upon nature of customer. It has been rightly set out in McCarthy on Trademarks and Unfair Competition about the said rule particularly in Para 23.15 which is reproduced hereunder:

23.15 Comparing Marks:
Differences v. Similarities

[1] The Anti-Dissection Rule

[a] Compare composites as a Whole :
Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison. This is the “anti dissection” rule. The rationale for the rule is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. However, it is not a violation of the anti-dissection rule to view the component parts of conflicting composite marks as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus, conflicting

⁹ (2015) 61 PTC 231

¹⁰ 211 (2014) DLT 296

marks must be compared in their entirety. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. As the Supreme Court observed: "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." The anti-dissection rule is based upon a common sense observation of customer behavior : the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in legal briefs. In litigation over the alleged similarity of marks, the owner will emphasize the similarities and the alleged infringer will emphasize the differences. The point is that the two marks should not be examined with a microscope to find the differences, for this is not the way the average purchaser views the marks. To the average buyer, the points of similarity are more important than minor points of difference. A court should not engage in "technical gymnastics" in an attempt to find some minor differences between conflicting marks.

However, where there are both similarities and differences in the marks, there must be weighed against one another to see which predominate.

The rationale of the anti-dissection rule is based upon this assumption: "An average purchaser does not retain all the details of a mark, but rather the mental impression of the mark creates in its totality. It has been held to be a violation of the anti-dissection rule to focus upon the "prominent" feature of a mark and decide likely confusion solely upon that feature, ignoring all other elements of the mark. Similarly, it is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains."

21. The view of the author makes it scintillatingly clear, beyond pale of doubt, that the principle of ‘*anti dissection*’ does not impose an absolute embargo upon the consideration of the constituent elements of a composite mark. The said elements may be viewed as a *preliminary step* on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus, the principle of ‘*anti-dissection*’ and identification of ‘*dominant mark*’ are not antithetical to one another and if viewed in a holistic perspective, the said principles rather compliment each other.

23. It is also settled that while a trademark is supposed to be looked at in entirety, yet the *consideration of a trademark as a whole does not condone infringement where less than the entire trademark is appropriated*. It is therefore not improper to identify elements or features of the marks that are more or less important for purpose of analysis in cases of composite marks.

26. Dominant features are significant because they attract attention and consumers are more likely to remember and rely on them for purposes of identification of the product. Usually, the dominant portion of a mark is that which has the greater strength or carries more weight. Descriptive or generic components, having little or no source identifying significance, are generally less significant in the analysis. However, words that are arbitrary and distinct possess greater strength and are thus accorded greater protection. [*Autozone, Inc. v. Tandy Corporation*¹¹]

(Emphasis in original)

Where, therefore, part of a composite mark is *dominant*, another mark, which copies or replicates that dominant part, may infringe. As *South India Beverages*⁹, this caveat does not violate the “anti dissection rule” statutorily engrafted in Section 17(2)(a) of the Trade Marks Act, as it merely identifies that part of the whole mark which, being dominant, confers, to the whole mark as registered, distinctiveness and exclusivity.

16. Where a family of marks is involved, as in the present case, the identification of the dominant part is greatly simplified. The very moniker that I have chosen to impart to the registered marks of the plaintiff – the ‘NOW’-family – itself identifies ‘NOW’ as the

dominant part of the mark family. It is but obvious that a viewer who views the TIMES NOW, ET NOW, ROMEDY NOW, MIRROR NOW and MOVIES NOW channels would identify NOW as the distinctive common feature of all the marks and, therefore, their “dominant” part.

17. The sequitur is obvious. If such a viewer, endowed with the mythical attributes of an average intelligence and an imperfect recollection, were to come across another channel, providing similar services, with a title of which ‘NOW’ is the latter part, there is every likelihood of his regarding the channel as part of the petitioner’s repertoire, or at least as having an association with the NOW-family of channels of the petitioner.

18. It is also important in this context to note the exact features of the impugned mark. Though the defendant had the impugned mark registered as a single word ‘VNOW’, the word ‘VNOW’ is unknown to the English language. It has no etymological meaning unlike, for example, ‘KNOW’ or ‘SNOW’. A person who has to pronounce the impugned mark would, therefore, pronounce it ‘vee-now’. The ‘NOW’ part of the impugned mark would be separately and distinctly intoned by any person who seeks to pronounce the impugned mark and, therefore, would have its own distinct identity even if it is not used as a separate word, as has been used by the plaintiff in respect of its ‘NOW’-family of marks.

19. The usage, by the defendant, of a different colour for the ‘NOW’ part of the impugned  mark further emphasizes its

distinct identity, even as part of the whole **VNOW** mark. Thus, even as seen visually, 'NOW' forms a distinct and separately identifiable part of the defendant's impugned mark. In that view of the matter, the mere fact that the impugned **VNOW** mark is written as one word and not as two words would not make any difference to the issue at hand.

20. Do, then, the various sub-sections of Section 11, as invoked by Ms Jha, apply, to disentitle the impugned **VNOW** mark to registration under the Trade Marks Act?

21. Section 11(1)(b):

21.1 Section 11(1)(b) proscribes registration of a trade mark which (i) is similar to an earlier trade mark and (ii) is used in respect of goods or services which are identical or similar to the earlier mark. Where these elements coalesce, and (iii) where it is found that, by such usage, a likelihood of confusion, or a likelihood of association, by the public, with the earlier trade mark, exists, the mark cannot be registered.

21.2 I have already held that the usage of 'NOW' as the latter part of the impugned **VNOW** mark renders the mark similar to the 'NOW'-family of marks registered in favour of the plaintiff, as 'NOW' constitutes the dominant part thereof. Where the dominant parts of two marks are identical, the marks have necessarily to be regarded as similar. The services, of which the petitioner seeks deletion from the array of services in respect of which the impugned **VNOW** mark stands registered, are identical to the services rendered by the plaintiff, in respect of which the marks in the 'NOW'-family stand registered. There is, therefore, every likelihood of an unwary member of the

public, who comes across the services of the defendant under the impugned **VNOW** mark, to presume an association with the petitioner or even regard the services as part of the petitioners oeuvre. The ingredients of Section 11(1)(b), therefore, stand satisfied.

22. Sections 11(2) and (3) vis-à-vis Section 11(5)¹²:

22.1 Section 11(2) of the Trade Marks Act proscribes registration of a mark which is identical with, or similar to, an earlier trade mark, even if the goods or services, in respect of which its registration is sought, are different from those in respect of which the earlier mark stands registered, provided (i) the earlier mark is a well known trade mark within the meaning of Section 2(1)(zg) of the Trade Marks Act and (ii) the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark. Section 11(3) proscribes registration of any trade mark if its use in India is liable to be prevented by the law of passing off or by the law of copyright.

22.2 Section 11(5), however, obviates the necessity of examining the applicability either of Section 11(2) or of Section 11(3). Section 11(5) clearly holds that a mark would not be refused registration on the grounds specified in sub-sections (2) and (3) of Section 11 unless an objection, on one of the grounds envisaged by Section 11(2) of Section 11(3), is raised in an opposition proceedings by the proprietor of the earlier trade mark, i.e., in the present case, the petitioner.

22.3 It is an undisputed position that no objection relatable to Section

¹² (5) A trade mark shall not be refused registration on the grounds specified in sub-sections (2) and (3), unless objection on any one or more of those grounds is raised in opposition proceedings by the proprietor of

11(2) or Section 11(3) was raised in opposition proceedings by the petitioner at or before the registration of the impugned **VNOW** mark in favour of the respondent.

22.4 Ms. Mamta Rani Jha sought to contend that Section 11(5) would apply only at the time when the mark is originally registered and that the rigour of the provision would not operate to dilute the applicability of Section 11(2) or 11(3) at the stage when cancellation of a registered mark is sought. I am unable to agree.

22.5 Once a mark is registered, Section 57 confers, on a person aggrieved by the registration, the right to seek its cancellation and consequent rectification of the register. The circumstances in which cancellation and rectification can be sought are circumscribed within sub-sections (1) and (2) of Section 57. Section 57(1) envisages cancellation or variation of the entry in the register where there is any contravention or failure to observe a condition entered on the register. That provision, quite clearly, does not apply to the present case.

22.6 Section 57(2) envisages removal of a mark from the register where either (i) the entry is made in the register without sufficient cause or (ii) the entry is wrongly remaining in the register or (iii) there is any error or defect in the entry in the register. If one or more of these three exigencies exists, the mark can either be expunged or varied from the register.

22.7 Of these three exigencies, the only exigency which could apply in the present case is the second i.e., that the defendant's mark is

continuing to wrongly remain in the register. *Etymologically*, a mark could be regarded as “wrongly remaining on the register” either (i) where it was correctly registered but, owing to intervening circumstances, its continuance on the register is impermissible, or (ii) where its very registration was bad, as the mark was non-registerable on account of one or more of the grounds envisaged in Sections 9 and 11 of the Trade Marks Act. I need not concern myself with the first of these two exigencies, as Ms Mamta Rani Jha has squarely relied on Section 11(1), (2) and (3), which imperil the very entitlement of the mark to registration, to canvass her case. Ms Jha’s submission is, therefore, that, as the impugned **NOW** mark was not entitled to registration and was, nonetheless, registered, its continuance on the register was impermissible in law; in other words, that it was “wrongly remaining on the register”.

22.8 The entitlement of the impugned mark to registration and the entitlement of the opponent of the mark to seek its cancellation or variation, thus, statutorily dovetail into one another. To be able to successfully contend that the respondent’s **NOW** mark was liable to be cancelled or varied, Ms Jha would have to successfully invoke one or more of the sub-sections of Section 9 or Section 11. All the rigours which statutorily apply to these provisions, and their invocability, would also, therefore, apply to Ms Jha’s attempt to do so.

22.9 I am, therefore, of the considered opinion that Section 11(5) does not apply differently at the stage when the application for registration of a mark is under consideration and when an application for rectification of the register and removal of a mark therefrom, under Section 57(2), has been made. Section 11(5) operates as a proviso to Sections 11(2) and 11(3), by excepting their applicability to cases in

which, at the time of consideration of the mark for registration, no opposition predicated on the said provisions is raised. If, therefore, no opposition predicated on Section 11(2) or 11(3) was raised by the petition when the defendant's **VNOW** mark was being considered for registration, the mark could not have been refused registration under Section 11(2) or 11(3). The corollary would, therefore, be that the grant of registration to the **VNOW** mark cannot be said to be improper, illegal or vitiated as being violative of Section 11(2) or 11(3).

22.10 As, admittedly, no opposition, predicated on Section 11(2) or 11(3) was raised by the petitioner at the time when the defendant's **VNOW** mark was proceeding to registration, the petitioner cannot urge Section 11(2) or 11(3) as a ground to seek its cancellation or variation.

23. In any event, as the grant of registration to the impugned mark of the defendant has already been found by me to be violative of Section 11(1)(b) of the Trade Marks Act, a clear case for rectification of the register and variation of the impugned mark as sought by the petitioner, so as to remove the handicap of Section 11(1)(b), is made out.

Conclusion

24. Resultantly, the Registration No. 2948252 dated 23rd April 2015 granted to the impugned **VNOW** mark in favour of the defendant in class 38 shall stand varied and, consequently, rectified by deleting, from the services in respect of which the impugned mark is registered, "Transmission, Reception & Sharing Of Downloadable Digital Data & Content, Electronic Communication Services, Providing Access To

GPS/Lbs/Other Navigation Services, Access To Electronic Communication Network, Web Casting/Online/ Offline Services For Transmission Or Reception Of Audio/Video/Data Files & Content, Multimedia, Access To Internet/Web Services/Tv/ Telecommunication Services Via Telecommunication Equipment Or Smart Phones Or Mobile Phones Or Wearable Devices Or Smart Watches Or Watches Or Wireless (2g/3g/4g/5g/7g/WIFI/WIMAX/VSAT) Enabled Devices Or GPS/ GPRS Enabled Device, Bluetooth Enabled Devices, Tablet Computer Transmission, Reception, Sharing & Communication Of Software Or Computer Applications Or Mobile Applications Or Smart Devices Applications Or Audio Or Video Or Downloadable Digital Content Or Web/ Internet /Online Data Sharing”.

25. The registration of the impugned mark shall, therefore, stand restricted to ‘smart security solution devices, power bank, chats or social networking services or conferences or webinars’.

26. The petition stands allowed accordingly.

27. Judgment to be uploaded on the website of this Court within 24 hours.

C. HARI SHANKAR, J.

FEBRUARY 14, 2023

dsn